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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,399	11/29/2000	William A. Fuss	D/99820690-009488-US(PAR)	9742

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07/28/2004

EXAMINER

NAKHJAVAN, SHERVIN K

ART UNIT PAPER NUMBER

2621

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/725,399

Applicant(s)

FUSS ET AL.

Examiner

Shervin Nakhjavan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,9-13,15,16,18-23 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13,15,16,18-23 and 25-29 is/are allowed.
- 6) ☒ Claim(s) 1-5 and 9 is/are rejected.
- 7) ☒ Claim(s) 10-12 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

Response to Arguments

1. Applicant's arguments, see the amendment, page 8, paragraph 2, filed 6-16-04, with respect to claims 1, 13, 20 and 25 have been fully considered and are persuasive-in-part. Specifically, applicant argues that Sonoda (US 6,014,453) does not teach both, validating by a code, or invalidating of the video image. Examiner agrees however, claim 1 does not incorporate such utility i.e. validating by applying a code combined with invalidation if necessary. Therefore, while the rejection of claims 13, 20, and 25 has been withdrawn, claim 1 is rejected in view of Sonoda et al..

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Sonoda et al. (US 6,014,453).

Regarding claim 1, Sonoda teaches, a process comprising: detecting at a first location if a video signal represents a selected type of image (Column 23, Lines 59-66, where the computer 110 performs the detecting at first location, by image processing device 200 of the kind of image data, in order to determine if the image or video data

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represents a selected type of image by acknowledging counterfeiting action based upon the probability judging of the image in the processor 200); receiving said video signal at a second location not in the same disclosure as said first location (Column 23, Line 64 through Column 24, Line 1, where the printer 120 is the second location to receive the video signal that is not in the same disclosure as the first location); and printing an image from said video signal at said second location if said video signal does not represent said selected type of image (Column 23, Line 64 through Column 24, Line 2, if it is determined that there is no counterfeiting is being done the video signal is sent to second location, printer 120 to be printed); taking corrective action if said video signal represents said selected type of image (Column 23, Line 64 through column 24, Line 3, where upon detecting of counterfeiting, the corrective action is taken to send "modify image" command to interface 113); wherein said corrective action comprises both invalidating said video signal and stopping said printing step (Column 23, Lines 61-66, wherein the outputting of the "modify image" command is the invalidating of the video signal and wherein upon receiving the "modify image" command at the interface unit 113, the unit stops the printing process of the original image by blackening or printing a reduced image of the video as discussed in Column 23, Line 64 through column 24, Line 3);

Sonoda teaches limitation of claim 2, said selected type of image represents a member of a group consisting of currency and negotiable securities (Column 13, Line 63 through Column 14, Line 4);

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Sonoda teaches limitation of claim 3, said detecting step comprises scanning an object at said first location to produce said video signal (Column 23, Lines 47-58, where the detecting is performed by the image processor 200 located at the scanner side 100 which scans the document before said detecting);

Sonoda teaches limitation of claim 9, said stopping step prevents printing even a partial image (Column 23, Line 64 through column 24, Line 3, turning the image black is the stop printing of even partial image which is the reduced version).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sonoda et al. in view of Roller (US 5,850,581).

Regarding claims 4 and 5, Sonoda teaches limitations of the claims substantially however, Sonoda does not specifically teach the printing steps being xerographically or by inkjet. Roller teaches, limitation of claims 4, said printing step comprises xerographically printing (Column 1, Lines 12-21);

limitation of claims 5, said printing step comprises ink jet printing (Column 1, Lines 23-28).

It would have been obvious to an ordinary skilled in the art to use xerographical or inkjet printing capabilities of Roller with Kai's system because xerographical printing is cost effective when using only black color and inkjet printing is more cost effective when using multiple colors (Column 1, Lines 18-27).

Allowable Subject Matter

6. Claims 10-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record specifically Sonoda et al. does not teach adding to said video signal a validation code at said first location if said video signal does not represent said selected type of image and checking for validation code at the second location of claim 10 combined with other features and elements of the claim.

7. The following is an examiner's statement of reasons for allowance: claims 13, 15, 16, 18-23 and 25-29 are allowed because while Sonoda teaches generating of a probability data for an image to be of a selected or non-selected type of images in a printing process, Sonoda fails to specifically teach adding a specific validation code when the video image is not of the selected type of image and/or checking for it's presence when printing, and invalidating the image if it is of the selected type, of claims 13, 20 and 25 combined with other features and elements of the claims.

Contact information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shervin Nakhjavan whose telephone number is (703) 306-5916. The examiner can normally be reached on Monday through Friday from 8:00 am to 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Boudreau, can be reached at (703) 305-4706.

Any response to this action should be mailed to:

Assistant Commissioner for Patents
Washington, DC 20231

Or faxed to:

(703) 872-9306 for *formal* communications, please mark "EXPEDITED PROCEDURE"

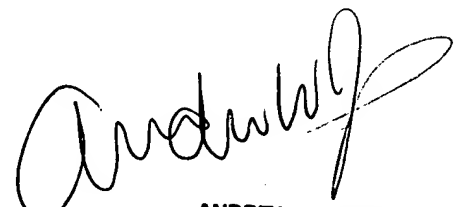
or:

for *informal* or *draft* communications; please label "PROPOSED" or "DRAFT".

Hand delivered responses should be brought to Crystal Park 2, 2121 Crystal drive, Arlington, VA, sixth floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Tech center 2700 customer service office (703) 306-0377.

Shervin Nakhjavan *S.N*
Patent Examiner
Group Art Unit 2621
July 23, 2004.


ANDREW W. JOHNS
PRIMARY EXAMINER